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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,669	05/13/2002	H. Darrel Darby	A7705	6168
23373	7590	03/07/2005		
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER PATTERSON, MARIE D	
			ART UNIT 3728	PAPER NUMBER

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/019,669

Applicant(s)

DARBY, H. DARREL

Examiner

Marie Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 33 and 34 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3, 6, 9, 12-30 and 35-40 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 7, 8, 10, 11, 31, 32, 41, and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

1. Claims 26-30, 37, 39, and 40 have been rejoined and examined due to the allowability of claims 25, 35, and 38 from which these claims depend.
 2. Claims 33 and 34 remain withdrawn as directed towards a nonelected invention.
- IT is noted that these claims depend from claim 32 which is not patentable/allowable and therefore there is no inventive concept present.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4, 5, 7, 8, 10, 11, 31, 41, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darby (5491909) in view of Darby (5370133) and Grim (5329705).

Darby '909 shows a shoe comprising an outsole (16), an upper (14), an insole assembly (18), and a shank (22) substantially as claimed except for the sole having a circumferential counter portion and the exact layered insole. Darby '133 teaches providing an outsole with a circumferential counter portion (shown as 16A in figure 1) which clearly shows an being of a height which would prevent shifting of all of the sole/insole layers, since it is shown in figures 1 and 7 as being taller than the topmost layer of the insole/sole. Grim teaches providing an insole with a plurality of different layers (52, 64, and 56) which are separably removable and are "capable of being

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rearranged in a different order" (due to the layers being completely detachable from one another) and one having a removable area (68) for use in a medical shoe. It would have been obvious to provide the outsole with a counter portion as taught by Darby '133 and to provide an insole having a plurality of different separable layers as taught by Grim in the shoe of Darby '909 to provide greater stability to the outsole/upper construction and to increase the cushioning and medial benefits of the insole construction taught by Grim.

5. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1, 2, 4, 5, 7, 8, 10, 11, 31, 41, and 42 above, and further in view of Kellerman (5799414).

Darby '909 as modified above shows an insole assembly substantially as claimed except for skiving the edges of the oval area. Kellerman teaches skiving/chamfering the edges of an opening (see column 5 lines 27-46). It would have been obvious to skive/chamfer the edges of the opening as taught by Kellerman in the insole assembly of Darby '909 as modified above to provide a smooth transition and to make the removable portion easier to remove.

Allowable Subject Matter

6. Claims 3, 6, 9, 12-30, and 35-40 are allowed.

Response to Arguments

7. Applicant's arguments filed 1/21/05 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards the newly added phrases in claims 1 and 31, it has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. In re Keller, 208 USPQ 871 (CCPA 1981). The modifying reference Darby (5370133) clearly shows and teaches a circumferential counter at 16A which also is part of element 34 which clearly is shown as extending up around the heel of the foot and therefore it clearly would result in preventing shifting of all of the layers of the footwear which are located below the foot of the wearer and above the sole layer.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9306 **(FORMAL FAXES ONLY)**. Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.



Marie Patterson
Primary Examiner
Art Unit 3728